

Serial No. 09/646,852, filed Sept. 22, 2000  
Docket No. 1103326-0636  
Page 7 of 10

### REMARKS

#### **I. Petition for Extension of Time**

A Notice of Appeal was filed March 5, 2004. Applicants herewith petition the Commissioner for Patents for a one-month extension of time extending the period for submitting this communication from May 5, 2004 to June 5, 2004. Authorization is given in the accompanying RCE Transmittal (PTO/SB/30) to charge the RCE fee of \$770.00 required under 37 C.F.R. §1.17(e) and the extension of time fee of \$110.00 (37 C.F.R. §§1.136 and 1.17) to Deposit Account No. 23-1703. Any deficiency or overpayment should be charged or credited to the above numbered deposit account.

#### **II. Prosecution History**

A final Office Action issued on September 8, 2003. Applicants submitted a response thereto on October 6, 2003 within the three-month shortened statutory period. The Examiner issued an Advisory Action, mailed October 28, 2003, maintaining the final rejection of record.

In response to the Advisory Action, Applicants submitted a supplemental Amendment after Final on December 18, 2003. A Notice of Appeal was filed March 5, 2004. A second Advisory Action was mailed May 6, 2004.

The claim amendment set forth in the supplemental Amendment was not entered because it was deemed that the proposed amendment did not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, the Advisory Action indicates that the proposed amendment renders the claims indefinite for failing to recite a range for the recited weight ratios.

Serial No. 09/646,852, filed Sept. 22, 2000  
Docket No. 1103326-0636  
Page 8 of 10

### **III. Claim Amendments**

Claim 1 has been amended to recite that the modifying agent and water insoluble polymer are present in the claimed delayed release dosage form in a weight ratio of from 90:10 to 50:50. Support is provided by original claim 19, now canceled, and by the disclosure appearing at page 8, lines 19-20 of the specification. New claim 28 is directed to the preferred embodiment disclosed at page 8, lines 22-23 of the specification. The remaining claim amendments concern the amended dependency of claims 23-26 in view of the cancellation of claim 19 and introduction of new claim 28. Applicants submit that the claim amendments are fully supported by the specification as originally filed and, therefore, no new matter has been added.

All of the remaining claims are dependent, either directly or indirectly, on claim 1. Accordingly, all of the pending claims are defined by the features of amended claim 1.

### **IV. Claim Rejection – 35 U.S.C. §103(a)**

Claims 1, 3-20 and 23-27 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Makino et al. (EP 0237 200) ("Makino") in view of Okada et al. (JP402237918) or US 5,776,489 to Preston et al.

Applicants rely on their arguments of record with respect to the prior art rejection. In addition, claim 1 has been amended to clarify that the modifying agent and water insoluble polymer are present in the claimed delayed release dosage form in a weight ratio of from 90:10 to 50:50. The recited range of weight ratios advantageously provides a formulation that is (1) acid resistant notwithstanding the absence of an enteric coat and (2) disruptable thereby providing a delayed release of the active ingredient.

Serial No. 09/646,852, filed Sept. 22, 2000  
Docket No. 1103326-0636  
Page 9 of 10

In contrast, the primary reference to Makino uses significantly smaller amounts of modifying agent, e.g., talc, relative to the water insoluble polymer, e.g., Eudragit®. In this regard, the Examiner's attention is directed to Example 9 of Makino at pages 14-15 (104.7 mg Eudragit® vs. 9.6 mg talc). Thus, Makino neither discloses nor suggests the claimed invention and advantages, i.e., acid resistant notwithstanding the absence of an enteric coat and disruptable to provide a delayed release of the active ingredient.

The secondary references also do not appear to disclose or suggest the recited ratio of modifying agent and water insoluble polymer.

For all of the foregoing reasons, Applicants submit that the cited prior art, whether taken alone or in combination, does not suggest the claimed invention. Withdrawal of the §103 rejection is requested.

FROM W&C LLP 19TH FL.

(FRI) 5.14' 04 13:12/ST. 13:09/NO. 4260454315 P 10

Serial No. 09/646,852, filed Sept. 22, 2000  
Docket No. 1103326-0636  
Page 10 of 10

**CONCLUSION**

Applicants have made a good faith attempt to respond to the Office Action. It is respectfully submitted that claims 1, 3-18, 20 and 23-28 are in condition for allowance, which action is earnestly solicited.

Any fees due in connection with this response should be charged to Deposit Account No. 23-1703.

Dated: May 14, 2004

Respectfully submitted,

John M. Genova  
John M. Genova  
Reg. No. 32,224  
Attorney for Applicants

Customer No. 07470  
White & Case LLP  
Agent Direct Dial: (212) 819-8437

Attachment

- PTO/SB/30